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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,792	11/20/2001	Andrzej W. Lipkowski	18475-025 (NEMC-6)	9119

7590 11/10/2004

Ingrid A. Beattie
Mintz, Levin, Cohn, Ferris,
Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

EXAMINER

FORD, VANESSA L

ART UNIT PAPER NUMBER

1645

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/988,792

Applicant(s)

LIPKOWSKI ET AL.

Examiner

Vanessa L. Ford

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 26 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the Advisory attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: 35 and 40-43.

Claim(s) rejected: 31-43 and 47-54.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Advisory attachment and Interview Summary.

Advisory Action Attachment

1. Applicant's amendment filed July 26, 2004 is acknowledged.
2. Applicants amendment is not entered because the claims as amended would require further consideration and require new searches. As amended the claims are directed to a composition comprising a fragment of a substance P peptide wherein said fragment inhibits growth of a bacterial cell and does not bind to a cell surface substance P peptide receptor and wherein said fragment consists of residues 1-8 of SEQ ID NO.1. The previous claims were directed to a composition that comprises a fragment of a substance P peptide wherein said fragment inhibits growth of a bacterial cell and does not bind to a cell surface substance P peptide receptor and wherein said fragment comprises residues 1-8 and does not comprise residue 9, 10 or 11 of SEQ ID NO:1. The difference between the previous claims and the amended claims would be that the previous claims require a substance P fragment that does not comprise at least one individual residue (i.e. 9, 10 or 11) of SEQ ID NO: 1. In other words the scope of the previous claims required that the composition comprises for example,
 - A) residues 1-9 of SEQ ID NO:1 or
 - B) residues 1-8 and 10 of SEQ ID NO:1 or
 - C) residues 1-8 and 11 of SEQ ID NO: 1.

The amended claims require that the substance P fragment does not require any of residues 9-11 of SEQ ID NO: 1. The newly amended claims also require that the fragments "consists of" residues 1-8 of SEQ ID NO:1 which is "closed claim language". The previous claims require that the fragments "comprises" residues 1-8 and does not comprise residue 9, 10 or 11 of SEQ ID NO.1. It should be remembered that "comprises or comprising" is "open claim language". Therefore, the scope of the claimed invention has changed by the newly added limitations and these limitations were not the subject of the searches in the previous Office actions. The claim limitations as amended have not been search or considered before the submission of the After Final Amendment.

Objections/Rejections Maintained

3. The Applicant's arguments regarding the rejection of claims 47-54 under 35 U.S.C. 112, first paragraph were addressed on pages 3-6, paragraph 4 of the previous Office Action.
4. The Applicant's arguments regarding the rejection of claims 47-54 under 35 U.S.C. 112, first paragraph were addressed on pages 3-6, paragraph 4 of the previous Office Action.
5. The objection of claim 35 on page 7, paragraph 6 of the previous Office Action is maintained.

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6. The objection of claims 40-43 on page 7, paragraph 7 of the previous Office Action is maintained.

7. The rejection of claims 32 and 33 under 35 U.S.C. 112, second paragraph page 7, paragraph 8 of the previous Office Action is maintained.

Status of Claims

8. No claims are allowed.

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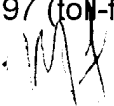
Conclusion


9. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Vanessa L. Ford
Biotechnology Patent Examiner
October 30, 2004


LYNETTE R. E. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600